

REMARKS

Claims 1 through 16 are pending in this Application. Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 1 and 9 were rejected under 35 U.S.C. § 102(b) for lack of novelty as evidenced by Hards et al (U.S. Pat. No. 5,501,915, hereinafter "Hards"). Applicant respectfully traverses.

As describes at col. 8, EXAMPLE 1 of Hards, PTFE (hydrophobic polymer) is added to Shawinigan acetylene black so as to produce a gas supplying component. The gas supplying component is used to produce an electrode. Accordingly, the electrode disclosed in Hards includes PTFE (hydrophobic polymer).

If a water-repellent material such as PTFE is used to provide water repellency, cell characteristics will be lowered over a period of time since the water-repellent material covers the surface of the catalyst particles. See page lines 22-27 of the present specification. Another disadvantage with including a water-repellent material such as PTFE is that the resistance of the electrode is increased.

The fuel cell electrode according to amended claim 1 does not include any additional water-repellent materials other than the second carbon particle. By not including extra water-repellent materials that may cause degradation in the performance of a fuel cell, a gas diffusion path and a moisture discharging path are secured in the catalyst layer, without degrading the performance of the fuel cell, as well as securing a three-phase interface. Consequently, a fuel cell electrode is provided with which it is possible to increase an output of the fuel cell and to maintain the output at a stable level.

The above argued functionally significant difference between the claimed electrode and the electrode disclosed by Hards undermine the factual determination that Hards disclose an electrode, and hence a fuel cell containing such electrode, within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection under 35 U.S.C. § 102(b) for lack of novelty as evidenced by Hards is not factually viable and, hence, solicits withdrawal thereof.

Dependent claims 2-4 and 10-12 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Hards in view of Terazono et al (U.S. Pat. App. Pub. No. 2002/0009626, hereinafter "Terazono"). Applicant respectfully traverses.

Dependent claims 5 and 13 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Hards in view of Koschany et al (U.S. Pat. No. 6,451,470, hereinafter "Koschany"). Applicant respectfully traverses.

This rejection is traversed. Specifically, claims 5 through 8 and 13 through 16 depend ultimately from independent claim 1. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of independent claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Hards. The secondary references to Terazono and Koschany do not cure the previously argued deficiencies of Hards. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejections under 35 U.S.C. § 103 for obviousness predicated upon Hards in view of Terazono and Hards in view of Koschany are not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS:dw
Facsimile: 202.756.8087
Date: July 30, 2007

**Please recognize our Customer No. 20277
as our correspondence address.**